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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/439,343

11/15/1999

ANDREW L. DIRIENZO

236.003US02

1539

27073 7590 03/17/2008
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EXAMINER

AL HASHEMI, SANA A

ART UNIT

PAPER NUMBER

2164

MAIL DATE

DELIVERY MODE

03/17/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/439,343	Applicant(s) DIRIENZO, ANDREW L.	
	Examiner Sam Rimell	Art Unit 2164	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 December 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 103-108, 112 and 152-196 is/are pending in the application.
- 4a) Of the above claim(s) 154, 155, 169, 176 and 178-196 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 103-108, 112, 152-153, 156-168, 170-175, 177 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Election Requirement: Applicant has elected Group I, claims 103-108, 112, 152-153, 156-168, 170-175 and 177 with traverse. Applicant argues that all the claims of Group I are the generic claims of Group II. Group I deals with ordering links according to bid amount, whereas Group II orders the link using both bid amount and additional variables. Accordingly, the inventions are patentably distinct and Group I is not considered to be generic of Group II. Nonetheless, if one of the elected independent claims is ever held as allowable, examiner agrees that the dependent claims of Group II could be re-instated, provided that these claims are not further amended. The restriction action is made final.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 103-108, 112, 152-153, 156-168, 170-175 and 177 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 103: Claim 103 has been amended to recite “..wherein each of the links is associated with a single one of the digital information blocks.” This feature is not taught or supported in the original specification. The only discussion of relations between links and information are set forth at pages 26 and 27.

The first two lines of page 26 state:

“Within the RAMIX Clearing House Computer are located Patient Bid Queues (PBQs) which contain a pointer or link to patient electronic medical images.” (underlining added).

The first three lines of page 27 state:

“The RAMIX system and operating method according to the present invention advantageously would include Physician Mail Boxes, which stores links, i.e. pointers to electronic medical images (EMIs) arranged in fee amount order..” (underlining added).

In each quote, the pointer is demonstrated as being linked to plural electronic images. In order to support the cited claim language, the specification would have to define the information block as being the plural images. However, since the specification never invokes or otherwise defines the term “information block”, and since distinct plural images would only suggest plural information blocks, the disclosure only suggests a link to plural information blocks, not a link to a single information block. Accordingly, the claimed feature is new matter.

Claims 104-106: Depend on claim 103.

Claim 107: Same rationale for claim 103.

Claims 108, 112: Depend on claim 107.

Claims 152-153: Depend on claim 103.

Claims 156-168: Depend on claims 103 and 107.

Claims 170-175: Depend on claim 107.

Claim 177: Depends on claim 107. Additionally, claim 177 recites the action of recording when a link has been used and to record when an information block has been downloaded. The original specification contains no discussion of recording link usage or block downloading in any manner of record, so this feature is additionally found to be new matter.

Art Unit: 2164

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 152-153, 156-158 and 170-175 are rejected under 35 U.S.C. 101 because the claimed invention is inoperable and therefore lacks utility.

Claims 152 and 174: Each of these claims calls for action of ordering a list by using electronic labeling. The mere presence of a label (i.e. text) on an electronic item will not result in that item being ordered into a list. Additionally, a "label" is a not parameter which could be used to determine the order of items in a sequential list. Accordingly, the invention is inoperable as claimed.

Claims 153, 175: Depend from claims 152 and 174 respectively.

Claims 156, 170: Claims 156 and 170 specify the actions of selecting a link, downloading an information block and taking some un-defined action in order to render payment for a bid. Payment requires a transfer of funds between two parties. Since these steps do not make any requirement for a transfer of funds, much less a transfer of funds between two parties, the payment action is not accomplished. Accordingly, the invention as claimed is inoperable.

Claims 157-158, 171-173: Depend on claims 156 and 170 respectively.

Remarks

Applicant's arguments are directed to the previously examined claims which are still of record, namely, claims 103-108 and 112. Applicant argues that the feature of "each link associated with a single one of the information blocks" is fully supported by FIG. 6 of the original drawings. The only discussions associated with FIG. 6 appear at page 21, last paragraph and page 38, first paragraph of the original specification, where no mention is made of either

links or digital information blocks. Applicant also asserts that the examiner's quotations from the original specification are misrepresentative of the subject matter. However, since these quotes are drawn from the actual text of the specification, they cannot be said to misrepresent the invention, since they are applicant's own description of the invention.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication should be directed to Sam Rimell at telephone number (571) 272-4084.

/Sam Rimell/

Primary Examiner, Art Unit 2164